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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/550,127

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Isabelle Dubois

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EXAMINER

MICALI, JOSEPH

ART UNIT

PAPER NUMBER

1793

NOTIFICATION DATE

DELIVERY MODE

09/18/2009

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

Patent-ch@btlaw.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/550,127	<b>Applicant(s)</b> DUBOIS ET AL.	
	<b>Examiner</b> Joseph V. Micali	<b>Art Unit</b> 1793	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 20 September 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>9/20/05</u> .   | 6) <input type="checkbox"/> Other: _____                          |

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## **DETAILED ACTION**

### ***Status of Application***

Claims 1-17 are pending and presented for examination on the merits.

### ***Priority***

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### ***Claim Objections***

2. Claims 1 and 5 are objected to because of the following informalities: “Hydroxly” is an apparent typographical error for “hydroxyl” (claim 1) and “pentaerytritol” for “pentaerythritol” (claim 5). Appropriate correction is required.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

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5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

**6. Claims 1, 5-7, and 9-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 5,447,563 by van Hoorn.**

With respect to claim 1, van Hoorn is drawn to a release composition (**title**). Specifically, van Hoorn discloses a composition (**claim 1**) comprising a fatty acid ester with between 4 and 24 carbon atoms (**column 3, lines 12-16**) and a neopentyl polyol containing three hydroxyl groups, such as trimethylolpropane and pentaerythritol (**column 3, lines 5-11**). Thus, as van Hoorn discloses such a release composition, van Hoorn also discloses a process involving application of such a release composition to moulds (**last line of abstract, and column 4, lines 1-8**).

With regards to the limitation of less than 0.2% by weight water, though, van Hoorn discloses an amount of water being 5% by weight (**column 3, line 35**).

However, **MPEP 2144.05 [R-5]** states that, “Generally, differences in concentration or temperature will not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such concentration or temperature is critical. “[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation.” This is such a case where the general

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conditions are set i.e. the claimed compounds are disclosed, and the amount of water selected does not provide any criticality as a release agent in the mould release composition, as one having ordinary skill in the art at the time the invention was made would have full faculty to select a preferred water amount tailored to composition's purpose or at the least by routine experimentation, simply by controlling the amounts of oil and water contained in the oil-in-water emulsion to one's preference (**van Hoorn, column 3, lines 33-35**).

With respect to claim 5, van Hoorn discloses a neopentyl polyol containing three hydroxyl groups, such as trimethylolpropane and pentaerythritol (**column 3, lines 5-11**).

With respect to claims 6-7, van Hoorn discloses a fatty acid ester with between 4 and 24 carbon atoms, overlapping the currently claimed range of 16 to 20 carbon atoms, with the acid ester being unsaturated (**column 3, lines 12-16**). See **MPEP 2144.05 [R-5] Overlap of Ranges**.

With respect to claim 9-10, van Hoorn discloses the ester being present in a proportion of 10-50% by weight, as van Hoorn discloses water being selected at 5% by weight (**column 3, line 35**) and the alcohol being selected at 5%-45% by weight (**claim 1**) with the rest of the composition comprising the ester. Thus, such a range overlaps both of the currently claimed ranges (10-100% and 20-60%). See **MPEP 2144.05 [R-5] Overlap of Ranges**.

**7. Claims 2-4 and 11-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 5,447,563 by van Hoorn, as applied to claims 1, 5-7, and 9-10 above, and further in view of US Patent No. 5,523,025 by Erilli.**

With respect to claims 2 and 4, van Hoorn is silent with regards to the addition of a terpene derivative and/or a component of inorganic origin.

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Erilli is drawn to a microemulsion light duty liquid cleaning composition (**title**). Specifically, Erilli discloses the addition of terpenes to such a composition as well as the addition of components of inorganic origin, such as paraffinic and aromatic oils (**column 2, lines 10-12, column 4, lines 35-36, and column 5, lines 14-16**).

At the time of invention it would have been obvious to a person of ordinary skill in the art to perform the process of van Hoorn including the addition of a terpene derivative and a component of inorganic origin, in view of the teaching of Erilli. The suggestion or motivation for doing so would have been to improve the removal ability of the composition by adding a strong removal solvent as well as improving the component dissolvability into the composition (**Erilli, column 2, lines 10-12, column 4, lines 35-40, and column 5, lines 3-13**).

With respect to claims 3 and 11, Erilli discloses the terpene derivative being a terpene alcohol, such as terpineol (**column 5, lines 14-16**).

With respect to claim 12, Erilli discloses the terpene derivative being a terpene alcohol, such as terpineol, specifically alpha-Terpineol (**column 5, lines 14-16**). By disclosing such an isomer, one having ordinary skill in the art at the time the invention was made would have been able to select multiple isomers to be used, with the suggestion or motivation of a substitution/addition of equivalents, as the properties of an isomer are dependent on the functional group, which in this case would be consistent throughout any and all of the possible isomers, i.e. the hydroxyl group of the alcohol.

With respect to claim 13, Erilli discloses the terpene derivative being present in an amount of 0 to 80% (**column 4, lines 35-40**), overlapping the currently claimed range of 0 and 90% by weight. See **MPEP 2144.05 [R-5] Overlap of Ranges**.

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With respect to claim 14, Erilli discloses components of inorganic origin, such as paraffinic and aromatic oils (**column 4, lines 35-36, and column 5, lines 14-16**).

With respect to claim 15, Erilli discloses the component of inorganic origin being present in an amount of 0 to 80% (**column 4, lines 35-40**), especially 10% (**column 5, lines 14-16**), overlapping the currently claimed range of 0 and 90% by weight. See **MPEP 2144.05 [R-5] Overlap of Ranges**.

With respect to claims 16-17, the modified method of van Hoorn discloses the composition having between 10-50% by weight ester and 0-80% by weight terpene derivative (**van Hoorn, column 3, line 35 and claim 1, and Erilli, column 4, lines 35-40**) overlapping with the currently claimed ranges of 30-90% or 35-50% by weight ester and 10-70% or 50-65% terpene derivative. See **MPEP 2144.05 [R-5] Overlap of Ranges**.

**8. Claims 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 5,447,563 by van Hoorn, as applied to claims 1, 5-7, and 9-10 above, and further in view of US Patent No. 6,176,914 by Feustel et al.**

With respect to claim 8, van Hoorn is silent with regards to the ester being a tall oil fatty acid ester, although disclosing an unsaturated fatty acid ester with between 4 and 24 carbon atoms.

Feustel is drawn to aromatic compound-free solvent for printing inks (**title**). However, Feustel discloses employing fatty acid esters as release agents (**column 2, lines 34-35**), with such fatty acid esters including unsaturated tall oil fatty acid esters (**column 3, lines 20-43**).

At the time of invention it would have been obvious to a person of ordinary skill in the art to perform the process of van Hoorn including the addition of a tall oil fatty acid ester as the

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ester, in view of the teaching of Feustel. The suggestion or motivation for doing so would have been to select an ester to improve solubility of the composition as well assist as a release agent (Feustel, column 2, lines 34-35, and column 3, lines 20-21).

***Conclusion***

9. Claims 1-17 are rejected.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph V. Micali whose telephone number is (571) 270-5906.

The examiner can normally be reached on Monday through Friday, 7:30am to 5pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry A. Lorengo can be reached on (571) 272-1233. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Joseph V Micali/  
Examiner, Art Unit 1793

/J.A. LORENZO/  
Supervisory Patent Examiner, Art Unit  
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